

REMARKS/ARGUMENTS

Prior to entry of this amendment, claims 1-3, 5-26 were pending in the application. No claims have been added, canceled or amended. Hence, after entry of this amendment, claims 1-3 and 5-26 will remain pending for examination.

§ 102 Rejections

A final office action mailed August 10, 2006, rejected claims 1, 2 and 5-20 under 35 U.S.C. § 102(e) as being anticipated by US Patent No. 6,859,806 to Kamarei et al. (“Kamarei”). These rejections are respectfully traversed, and reconsideration of the rejections is respectfully requested.

As pointed out in an amendment dated July 18, 2006, Kamerai fails to teach or suggest each element of any pending claim, and any § 102 rejection founded on Kamerai is, therefore inappropriate. In particular, as the earlier amendment noted, Kamerai fails at least to disclose “wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case,” as recited, for example, by claim 1.

In response to this argument, the final office action noted that Kamerai teaches that a governmental system might attach a document to a docket request message (citing Kamerai, c. 10, ll. 64-67) and that Kamerai teaches that various documents might be generated in relation to a case (citing Kamerai, c. 11, ll. 40-67 and c. 13, ll 55-63). Even assuming this is an accurate characterization of Kamerai, this disclosure fails to disclose the cited element, either expressly or inherently. Specifically, the final office action identifies nothing in Kamerai that even remotely teaches the storage of such documents, let alone the storage of such documents in a case data unit that stores data related to the first intellectual property case and one or more documents related to that case, as recited by claim 1.

A proper rejection under § 102(e) requires “each an every element as set forth in the claim [to be] found, either expressly or inherently described, in a single prior art reference.”

MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). The final office action's § 102 rejection of claim 1 fails to meet this standard and therefore are improper. At least because of this failure of Kamerai to disclose document storage, the rejections of independent claims 11, 16 and 17 are believed to be improper as well. Dependent claims 2, 5-10, 12-15 and 18-20 are believed to be allowable at least by virtue of their dependence from allowable base claims.

Accordingly, applicants respectfully submit that the § 102(e) rejections must be withdrawn and that a new, non-final office action should be mailed if the Office believes that a § 103 rejection over Kamerai is appropriate. However, as pointed out in the applicants' earlier amendment, Kamerai is insufficient to support even a rejection under § 103, as it provides no suggestion or motivation to store documents within a case data unit (and, indeed, discloses no facility that might be modified to provide this functionality).

§ 103 Rejections

Claims 3 and 21-26 stand rejected under § 103(a) as unpatentable over Kamerai, taken either alone or in combination with US Patent No. 7,016,852 to Lee ("Lee"). While the applicants believe that this rejections are not well-taken, in the interest of brevity, they simply assert, for the present, claims 3 and 21-26 are allowable at least by virtue of their dependence from allowable base claims.

The applicants do, however, traverse the office action's official notice of the fact that "it is old and well-known in the art of document scanning to scan documents using optical character recognition." In addition, the applicants traverse the implicit assertion that it was known in the art to scan and OCR a document related to an intellectual property case and include the results of the OCR in the information about that case stored on a docketing system. The applicants submit that this novel feature of one embodiment of applicants' claimed invention was not well known in the art at the time the present application was filed, and pursuant to MPEP § 2144.03, respectively request a reference illustrating this feature or an affidavit of personal knowledge of this feature.

Appl. No. 09/996,341

PATENT

Amdt. dated October 10, 2006

Amendment under 37 CFR 1.116 Expedited Procedure Examining Group 3623

Conclusion

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: October 10, 2006

/Chad E. King/

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Attachments

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